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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/361,425 07/27/99 KUNG

J JBP461

EXAMINER

HM12/0727

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ART UNIT	PAPER NUMBER
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1653

19

DATE MAILED:

07/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/361,425	Applicant(s) KUNG ET AL.	
	Examiner Chih-Min Kam	Art Unit 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14,18</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Status of the Claims

1. Claims 1, 2, 5-13 and 15 are pending.

Applicants' response filed on June 4, 2001 (Paper No. 17) has been fully considered.

Rejection Withdrawn

Claim Rejections - 35 USC § 103

2. The previous rejection of claims 1, 2, 5-13 and 15 under 35 U.S.C.103(a), as being unpatentable over Robinson *et al.* (WO 97/21423) taken with Mason *et al.* (US 5,691,380) is withdrawn in view of applicants' response cited on pages 2-5 in Paper No. 17.

Claim Objections

3. Claim 1 is objected to because of the following informalities: the term "one or more stabilizer compounds selected from the group consisting of: a) thio-containing compounds" is not proper since the thio-containing compounds is the only group used for stabilizer compounds. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 5, 6, 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because of the use of the term "one or more stabilizer compounds". The term "one or more stabilizer compounds" renders the claim indefinite, it is

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unclear how many stabilizer compounds are contained in the composition. Claims 2, 5, 6, 8-13 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

4. Claims 1, 2, 5-7, 11-13 and 15 are indefinite because of the use of the term "more than one oxygen-labile species". The term "more than one oxygen-labile species" renders the claim indefinite, it is unclear how many more of oxygen-labile species besides retinoid are contained in the composition. Claims 2, 5-7, 11-13 and 15 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

5. Claims 2, 5, 6, 8-10, 12 and 13 are indefinite because of the use of the term "derivatives". The term "derivatives" renders the claim indefinite, it is unclear what kind of compounds are as compared to the parent compound.

6. Claim 6 recites the limitation "water-soluble oxygen-labile species" in line 1. There is insufficient antecedent basis for this limitation in the claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5, 6 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Clum *et al.* (WO 93/00085).

Clum *et al.* teach a skin care composition comprising a water-in-oil emulsion, retinoids, and a stabilizing system selected from the group consisting of: a) a chelating agent and at least

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one oil-soluble antioxidant; b) a chelating agent and at least one water-soluble antioxidant; c) antioxidant present in each of the oil and water phases of the emulsion, and the composition retains at least about 60% of retinoids after 13 weeks storage at 40 °C (page 9, line 13-page 10, line 4). The composition containing retinoids and the water-soluble antioxidants such as ascorbic acid, sodium sulfite and cysteine hydrochloride meets the criteria of claims 1, 2, 6 and 10-12 (page 11, line 17-page 12, line 9). The composition containing retinoids and the oil-soluble antioxidants such as butylated hydroxyanisole (BHA, a thio-containing compound) and α -tocopherol meets the criteria of claims 1 and 5 (page 12, lines 11-18).

8. Claims 1, 2, 5, 6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu *et al.* (WO 97/31620).

Liu *et al.* teach a skin care composition comprising a water-in-oil emulsion, retinoids, and a stabilizing system selected from the group consisting of: a) at least one oil-soluble antioxidant; b) a chelating agent and at least one oil-soluble antioxidant; c) a chelating agent; d) a chelating agent and antioxidant present in each of the oil and water phases of the emulsion, and the composition retains at least about 70% of retinoids after 13 weeks storage at 40 °C (page 6, lines 9-21). The composition containing retinoids and antioxidant present in each of the oil and water phases of the emulsion such as ascorbyl palmitate and cysteine hydrochloride meets the criteria of claims 1, 2, 6 and 10-12 (page 14, lines 14-26). The composition containing retinoids and the oil-soluble antioxidants such as glutathione, ascorbyl palmitate and α -tocopherol meets the criteria of claims 1, 2, 5, 8-13 (page 14, lines 14-20; page 83, Example 30).

Conclusion

9. No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D.
Patent Examiner

July 23, 2001

Christopher S. F. Low
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